

By concl.
said tag,

~~a means for communicating said data to said tag.~~

REMARKS

SECTION I

EXAMINER'S REJECTION OF CLAIMS 1, 3-4, 6, 10-11, 13-16, & 19

UNDER 35 U.S.C. § 102(a)

CLAIMS 1 & 3

Claims 1 and 3 are cancelled.

CLAIMS 4 & 6

Claim 4 is amended to include the limitations of cancelled claims 1 and 3.

Claims 4 and 6 include "a means for receiving data to be substituted for said alterable data by said altering means" which is not disclosed by Hogen Esch et al. (U.S. Pat. 5,103,222, hereafter referred to as '222) in the "full, clear, concise and exact terms" required by 35 U.S.C. § 112. The only matter in Hogen Esch et al. that relates to Applicant's "receiving data means" are element 26 in Fig. 2 and the words

". . . a programmer device 26 is provided, which is capable of decoding an information carrying signal induced in coil 3 . .

. ." ('222, col. 4, lines 20-22).

This statement identifies the function to be accomplished by the "programmer device" but does not provide any insight as to how the function is to be accomplished. There is no information as to the nature of the information being communicated nor is there any indication as to how the information is embedded in the information carrying signal. There is nothing to suggest the possibility of Applicant's "receiving data means" being direct connections between the programming circuitry and memory as described in Applicant's specification, p. 15, lines 7-10.

The Applicant believes that Hogen Esch et al.'s functional definition of their "programmer device" does not disclose the Applicant's "means for receiving data" in that it is not a description "in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the [invention]"

CLAIMS 10 & 11

Hogen Esch et al. do not disclose "a means for receiving data from a user" nor do they disclose "a means for communicating said user data" to a tag. The entire Hogen Esch et al. disclosure that relates to claim 10 consists of elements 1, 2 and 35 of Fig. 1 and the words:

". . . programming means 35 (FIG. 1)." ('222, col. 4, lines 16-17); and

". . . a transmitter and a receiver combined into a

transmitter/receiver 1, which includes a transmitter/receiver coil 2." ('222, col. 2, lines 35-37).

The Applicant believes that the two-word disclosure "programming means" does not constitute a description of the Applicant's "means for receiving data from a user" adequate for anticipation in that it does not meet the requirements of 35 U.S.C. § 112 that call for a written description "in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same" Hogen Esch et al. provides no information as to: (1) how a user inputs data; (2) whether the data can be inputted in real time; (3) how the data is formatted for transmission to a tag; (4) whether the data is formatted by the user or by the programming unit; (5) whether the data to be transmitted is of fixed or arbitrary length; (6) how unauthorized reprogramming of the tag memory is avoided; (7) how the transmission of data to a tag is initiated; and (8) whether the reprogramming of the tag can be verified by the user.

The Applicant also believes that Hogen Esch et al.'s "transmitter/receiver" combined with "programmer device . . . capable of decoding an information carrying signal" would not provide sufficient guidance to a skilled artisan in making and using Applicant's "means for communicating said user data" to a tag. Hogen Esch et al. provides no information relating to: (1) the means for impressing information on the information carrier; (2) the means by which a tag recognizes the origin of an interrogation (i.e. reader or programming unit); (3) the means by

which a tag recognizes the arrival of a modulated interrogation signal; (4) the means by which a tag extracts the information from a modulated interrogation signal; and (5) the desirable probabilities of falsely recognizing and of truly recognizing the presence of a modulating signal.

CLAIM 13

Since claim 13 depends from claim 10, Applicant believes that Hogen Esch et al. do not anticipate claim 13 for the same reasons that Hogen Esch et al. do not anticipate claim 10.

CLAIM 14

Since claim 14 depends from claims 13 and 10, Applicant believes that Hogen Esch et al. do not anticipate claim 14 for the same reasons that Hogen Esch et al. do not anticipate claims 13 and 10.

Applicant also believes that Hogen Esch et al. do not provide enough information relating to Applicant's "means for receiving data to be substituted for said alterable data by said altering means" to constitute anticipation. Please see discussion under the CLAIMS 4 & 6 heading.

CLAIMS 15 & 16

Claims 15 and 16 are for a method of storing and altering data in an electronic identification tag which includes the steps of receiving and storing data in unalterable memory. Hogen Esch et

al. state that the memory contained in digital circuit 6 "may or may not be re-programmable, either in full or in part" ('222, col. 3, lines 7-8) but says nothing about how data is received and stored in the part of the memory that is not re-programmable. Since Hogen Esch et al. do not disclose two of the steps in Applicant's method claims, Applicant believes that Hogen Esch et al. do not anticipate Applicant's claim 15 and 16.

CLAIM 19

Claim 19 claims a tag that includes "a means for receiving data to be substituted for said alterable data by said altering means"--also an element of claim 4. The Applicant believes that Hogen Esch et al. do not anticipate this element of the Applicant's invention for the reasons given under the CLAIMS 4 & 6 heading.

Claim 19 also claims a reader that includes "a means for receiving data from a user to be substituted for said alterable data stored in said alterable storage means in said tag" and "a means for communicating said received data from the user to said tag"--elements that also appear in claim 10. The Applicant believes that Hogen Esch et al. do not anticipate these two elements of the Applicant's invention for the reasons given under the CLAIMS 10 & 11 heading.

SECTION II

EXAMINER'S REJECTION OF CLAIMS 2, 5, 7-9, & 17-18

UNDER 35 U.S.C. § 103

CLAIM 2

Claim 2 is amended to include the limitations of cancelled claim 1.

The claim 2 limitation whereby "said alterability [of the contents of the alterable memory means] is subject to permanent disablement" is not disclosed by Hogen Esch et al. nor is it disclosed by Anders et al. (U.S. Pat. 4,656,463, hereafter referred to as '463).

In fact, the focus of both Hogen Esch et al. and Anders et al. are on "reprogrammable" memories. Permanent disablement of the reprogramming capability associated with their reprogrammable memories would defeat the purposes of their inventions.

The Applicant believes that a conclusion of obviousness is unjustified where neither of the references provided by the Examiner contains any discussion whatsoever relating to the need, possibility, or desirability for permanently disabling the reprogramming feature of the reprogrammable memories of their inventions.

CLAIM 5

The Applicant believes that the issue of obviousness does not arise insofar as claim 5 is concerned. If the Applicant is correct

in his belief that claim 4 is not anticipated by Hogen Esch et al. (see discussion under CLAIMS 4 & 6 in SECTION I), then claim 5, which depends from claim 4, should also be patentable.

CLAIMS 7-9

Claim 7 is amended to include the limitations of cancelled claim 1.

Claim 7 includes "a means for temporarily storing data" to be communicated to an electronic identification reader. The Applicant's "temporary storage means" is exemplified by such volatile memories as FIFOs and RAMs which are used for the storage of data from sensors attached to the electronic identification tag (Applicant's specification, p. 15, lines 24-25, p. 16, lines 1-3; claims 8 & 9). It should be noted that the sensor data storage function is performed only when the tag is being interrogated. The "temporary storage means" does not need to retain the data between interrogations. Consequently, the FIFO or RAM do not need auxiliary sources of power (such as a battery). The power derived from the interrogation signal is sufficient for the purposes of the Applicant's invention.

Anders et al disclose the use of RAM but only in combination with ROM ('463, col. 11, lines 50-51) and they point out that the RAM must be powered at all times ('463, col. 12, lines 1-2).

The Applicant believes that the use of a FIFO or a RAM all by itself is not obvious in view of Anders et al. who actually teach away from using RAM in this fashion.

CLAIMS 17 & 18

If the Applicant is correct in his belief that claim 15 is not anticipated by Hogen Esch et al. (see discussion under CLAIMS 4 & 6 in SECTION I), then claim 17, which depends from claim 15, should also be patentable.

In any event, the limitation "receiving data to be temporarily stored in memory" (which Applicant's specification makes clear refers to data obtained from sensors attached to the tag--see discussion under CLAIMS 7 & 9 , SECTION II) has no parallel in the disclosures of Hogen Esch et al. and Anders et al. These two references are concerned only with data that has its origin in a transmitter ('222, col. 4, lines 20-24) or an active transceiver (AT) ('463, col. 26, lines 36-38). Consequently, the "receiving data to be temporarily stored in memory" step cannot be considered obvious since neither reference discloses it.

The method of claim 18 comprises the additional step of "communicating said unalterable data, said alterable data, and said temporary data to an electronic identification reader". Since Hogen Esch et al. and Anders et al. are not concerned with "temporary data" in the sense that it is used in Applicant's specification, it would appear that neither of these references can serve as the basis for an obviousness conclusion with regard to this step of claim 18.

SECTION III
EXAMINER'S REJECTION OF CLAIM 12
UNDER 35 U.S.C. § 103

CLAIM 12

The Applicant believes that the issue of obviousness does not arise insofar as claim 12 is concerned. If the Applicant is correct in his belief that claims 10 and 11 are not anticipated by Hogen Esch et al. (see discussion under CLAIMS 10 & 11 in SECTION I), then claim 12, which depends from claims 10 and 11, should also be patentable.

SECTION IV
EXAMINER'S REJECTION OF CLAIMS 10-14
UNDER 35 U.S.C. § 112

CLAIMS 10-14

The phrase "independent of the reader" has been deleted from claim 10 thereby overcoming the Examiner's objection that there was no antecedent basis for "the reader".

SECTION V

EXAMINER'S OBJECTIONS TO INFORMALITIES IN DISCLOSURE

The Examiner's objections have been noted and appropriate amendments have been made in the disclosure.

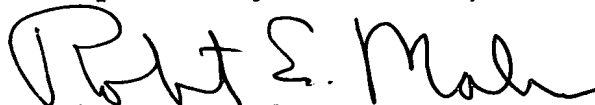
SECTION VI

REQUEST FOR RECONSIDERATION OF REJECTIONS

The Applicant respectfully requests reconsideration by the Examiner of his rejection of claims 4, 6, 10-11, 13-16, & 19 under 35 U.S.C. § 102(a), his rejection of claims 2, 5, 7-9, 12, & 17-18 under U.S.C. § 103, and his rejection of claims 10-14 under 35 U.S.C. § 112 in view of the information presented herein.

The Commissioner is hereby authorized to charge any fees under 37 CFR 1.16 and 1.17 which may be required by this paper to Deposit Account No. 13-1239.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Robert E. Malm". The signature is fluid and cursive, with the first name "Robert" being more prominent and the last name "Malm" following in a similar style.

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